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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,076	10/16/2003	Joseph Henry	TXT-003	9086

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EXAMINER

SELLS, JAMES D

ART UNIT PAPER NUMBER

1734

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/687,076

Applicant(s)

HENRY, JOSEPH

Examiner

James Sells

Art Unit

1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 14 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-5 is/are allowed.
- 6) ☒ Claim(s) 6-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12-22-03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-14, drawn to a method and apparatus for splicing weatherstripping, classified in class 156, subclass 73.4.
  - II. Claim 15, drawn to a spliced weatherstripping, classified in class 428, subclass 57.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process such as radio frequency welding or resistance heat welding instead of ultrasonic welding.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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4. During a telephone conversation with Mr. John Forcier (42,545) on December 3, 2004 a provisional election was made with traverse to prosecute the invention of group I, claims 1-14. Affirmation of this election must be made by applicant in replying to this Office action. Claim 15 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 6, 8, 10, 12 and 14 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Swards (US Patent 4,505,780).

Swards discloses a system for joining weatherstrippings. As shown in Fig. 1, the apparatus comprises base 10 with weatherstripping holders or tracks 13 and 14, which are slidable in the base 10. Heated knives or blades 17 are coupled to the base for cutting the weatherstrippings. Ultrasonic horn welds two abutting strips of weatherstripping.

The applicant is reminded that the materials used (i.e. weatherstripping comprising a sealing element and a backing element) are not germane to the patentability of an apparatus claim.

Applicant is also reminded that the method of use (i.e. the first and second pieces of weatherstripping are in overlapping contact) is also not germane to the patentability of an apparatus claim.

7. Claims 6-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Kanda et al (US Patent 5,123,992).

Kanda discloses a tape splicer. As shown in Figs. 1-3, the apparatus comprises base 1 with groove or track 19 for receiving recording tape. Pins 19 function as applicant's claimed stop. Cutter 26 includes stationary blade 27 and movable pivoting or rotating blades 28 and 29. Knobs 33 and 34 function as applicant's claimed handle.

As stated above, the applicant is reminded that the materials used (i.e. weatherstripping comprising a sealing element and a backing element) are not germane to the patentability of an apparatus claim.

8. Claims 10-11 and 13-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Becking (US Patent 5,304,266)

Becking discloses a ribbon welding system. As shown in Figs. 1-3, ends 114 and 116 of ribbon 112 are positioned in channels defined by guide plate 186 and clamped by ribbon clamp assemblies 154a and 154b of welder 100. Cutter assembly 152 cuts the ribbons and ultrasonic welding horn presses and 180 welds the ribbon ends together.

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As stated above, the applicant is reminded that the materials used (i.e. weatherstripping comprising a sealing element and a backing element) are not germane to the patentability of an apparatus claim.

***Allowable Subject Matter***

9. Claims 1-5 are allowed.

10. The following is a statement of reasons for the indication of allowable subject matter:

Regarding claim 1, in a method of splicing weatherstripping including a sealing element and a backing element, the prior art does not teach or make obvious the concept of the combination steps comprising cutting a portion of the sealing element from a first piece of weatherstripping, leaving an exposed portion of the backing element, overlapping the exposed portion of the backing element with a backing element of a second piece of weatherstripping and ultrasonically joining the exposed portion of the backing element of the first piece of weatherstripping to the backing element of the second piece of weatherstripping in the manner claimed by the applicant.

***References***

11. References C-E are cited as prior art of interest.

***Telephone/Fax***

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Sells whose telephone number is (571) 272-1237. The examiner can normally be reached on Monday-Friday between 9:30 AM and 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla can be reached at (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

A handwritten signature in black ink, appearing to read 'J Sells', with a horizontal line drawn underneath the name.

**JAMES SELLS  
PRIMARY EXAMINER  
TECH. CENTER 1700**